

## **REMARKS**

Claims 1-43 are now pending in this application. Claims 1 and 15-41 are currently amended. Claims 42 and 43 are new.

The following remarks are in response to the Office Action mailed June 8, 2004.

### **Informalities**

#### **A. Oath/Declaration**

The declaration was objected to as not including the mailing addresses of the inventors. Applicants were instructed to include that information in either an application data sheet or a supplemental declaration. An application data sheet including the inventors' addresses is included with this Response.

#### **B. Abstract**

The Office Action required an abstract to be submitted. An abstract is submitted above, as an amendment to the specification.

#### **C. Figure Descriptions**

The descriptions of FIGs. 2 and 3 were objected to as not being sufficiently descriptive. The specification has been amended above to correct that problem.

#### **D. Unclear Claims**

Claims 15 and 17 were objected to as being indefinite (grammatically incorrect). Those claims have been amended in accordance with the suggestions made by the Patent Office.

### **Claim Rejections**

Claims 1-41 were rejected under 35 U.S.C § 112 as indefinite, on the ground that "it is unclear to the Examiner how the recited steps are 'marketing mortgage and/or credit services' as stated in the preamble to the claims." Applicants respectfully traverse this rejection and submit that the asserted ground is insufficient to support a § 112 rejection. However, to advance prosecution of the application, the claim preambles have been amended to change "marketing" to "providing."

Claims 1-21 were rejected under 35 U.S.C § 101 as directed to non-patentable subject matter. This rejection is respectfully traversed.

The Patent Office appears to be creating, *ex nihilo*, patentability requirements that are not supported by statute, regulation, or court precedent. Claim 1 has apparently been rejected, not because it lacks any recitation of technology in the body of the claim (a spurious requirement in itself -- see discussion below), but because “it does not specifically tie ... Internet usage with the main crux of the claimed invention.” Applicants respectfully submit that there is no such requirement in patent law, and respectfully request the Patent Office to withdraw its § 101 rejection of claims 1-21. In the alternative, Applicants respectfully request the Patent Office to provide a citation to a statute, regulation, or decision by the United States Supreme Court or Court of Appeals for the Federal Circuit that supports the rejection of claim 1 on the ground that “it does not specifically tie ... Internet usage with the main crux of the claimed invention.”

Moreover, the Office Action improperly relies on the unpublished decision *Ex parte Bowman*. This reliance is misplaced for at least three reasons. First, the *Bowman* decision was unpublished. That is, the decision “was not written for publication, and is not binding precedent of the [B]oard.” *Bowman*, 61 U.S.P.Q.2d at 1670. In other words, the Board itself was not willing to be bound by the decision. Applicants respectfully submit that they are likewise not bound by the decision, and that rejections (if any) of their claims should be based on actual law – not unpublished, non-precedential opinions.

The Office Action asserts that it relies on the “content and reasoning” of *Bowman*, despite the fact that the decision is not precedential. But this assertion ignores the fact that the decision was not published and not considered worthy of precedential status. If the Board thought reliance on the content and reasoning of *Bowman* was proper, it would have published the decision. And if the Patent Office could properly rely on the content and reasoning of unpublished decisions, then designating decisions as “not to be published” would be meaningless – it would have no practical effect. Obviously that is not what the Board intended.

Second, the Office Action misstates the holding of *Bowman*. The Board did not say that “claims lacking any technology are ‘nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.’” The Board stated: “In summary, we find that the invention before us is nothing more than an abstract idea which is not tied to any technological art, environment, or machine, and is not a useful art as

contemplated by the Constitution of the United States.” *Bowman*, at 1671. Thus, the Board was making a specific statement about Bowman’s invention – not a general statement about claim requirements.

Third, although the *Bowman* Board affirmed claim rejections on the ground that the claimed invention was not tied to any “technological art, environment, or machine,” it provides no guidance as to what constitutes a “technological art.” Thus, even if the decision were precedential, it provides no guidelines whatsoever that could be used by Applicants to determine whether the claimed invention does or does not “fall within the definition of technological arts.”

In any event, the Office Action admits that claim 1 does include a recitation of technology (the Internet) in the body of the claim, so Applicants respectfully submit that even if reliance on *Bowman* was proper, *Bowman* does not support a rejection of claim 1.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 5,966,699, to Zandi. This rejection is respectfully traversed.

Applicants respectfully submit that the Patent Office has misperceived the nature of the claimed invention. The invention to which claim 1, for example, is directed is a method for providing “front-end” or “front-office” services – not “back-office” services such as actually processing a mortgage application. As the claim indicates, the method is directed to collecting certain (very specific) information from a user, then (based on that information) providing the user with information regarding mortgage and/or credit options that correspond to the user’s needs. All of the steps recited in claim 1 typically occur before a lender has processed or even reviewed a loan application.

In contrast, Zandi discloses a computer system for conducting an electronic loan auction over the Internet (see Abstract). Thus, almost all steps in Zandi would be performed *after* (not *before*) a user has decided whether to apply for a loan, and decided what sort of loan to apply for. Although Zandi does briefly mention (at column 6, for example) providing some non-user-specific, generic loan information to a potential borrower before a loan is applied for, Zandi fails to disclose the invention claimed by Applicants.

In particular, col. 3, lines 1-5 and col. 6, lines 1-22 do not disclose the claim 1 step of selectively providing information concerning a plurality of mortgage and/or credit programs to

an Internet-connected user. Col. 3, lines 1-5 begin: “During the time a loan of a borrower is in the database . . . .” Thus, that excerpt discusses post-loan-application steps (the loan application already exists and is in a database). At that stage, “providing information concerning a plurality of mortgage and/or credit programs” would be useless.

Likewise, column 2, lines 15-31 fails to disclose the claim 1 element of receiving an indication of whether the user wishes to explore home financing options or home equity loan options. The only pre-application step mentioned at column 2, lines 15-31 is “making available a computer loan application software [sic] including a loan application to a prospective borrower over the computer network.” No mention is made of receiving an indication from a user of whether the user wishes to explore home financing options or home equity loan options.

Likewise, column 7, lines 54-61 merely discusses generic pre-application steps:

Before a prospective borrower applies for a loan/mortgage through the auction system, he/she may first visit Web site 22 on server computer 20. Web site 22 describes the loan auction process and provides information about the current mortgage environment. If the prospective borrower is interested to proceed further, he/she may download and fill out the electronic pre-qualification form to see if he/she is in the ball park of their desired loan or mortgage.

The above excerpt doesn’t mention “receiving, from said Internet-connected user, an indication of whether or not said user maintains an asset and/or brokerage account with a sponsor of said mortgage and/or credit services.” No mention is even made of an asset and/or brokerage account of a sponsor.

Confusingly, the Patent Office cites column 8, lines 1-12 as disclosing the claim 1 limitation of receiving an indication of the user’s residence, but then (correctly) admits that Zandi does not disclose that limitation. The Examiner then takes Official Notice that “it is well known in the art that *loan applications* have the applicant’s residence so as to properly identify the applicant and provide an address for future correspondence.” But this merely further evidences a misunderstanding of applicants’ invention: it is not a loan-application process. It is a mortgage/credit-information-providing process. Claim 1 does not comprise a loan application step.

The Official Notice taken by the Examiner is respectfully traversed. Reliance on what may or may not be known regarding loan applications is inappropriate. In any event, pursuant to MPEP § 2144.03, applicants respectfully request the Patent Office to provide documentary evidence of all alleged facts being Officially Noticed.

The Office Action asserts that column 9, lines 1-10 of Zandi discloses the claim 1 limitation of receiving information concerning a property to be financed, said information including at least location, expected holding period, and use of said property. But column 9, lines 1-10 of Zandi only mentions providing the location of property. No mention is made of expected holding period or of the use of the property.

Also regarding the rejection of claim 1, the Office Action apparently asserts that column 8, lines 1-12 of Zandi discloses the claim 1 limitation of receiving information concerning a user's investments - but then correctly admits that Zandi does not disclose that limitation. The Examiner then takes Official Notice that "it is well known in the art for loan applications to contain investment information so as to provide an accurate picture of the [person's] net worth, obligations and their ability to repay the loan." This assertion further indicates that the Patent Office has not appreciated the process to which applicants' invention is directed. Again, claim 1 is not directed to a loan application process. Thus, assertions regarding loan application prior art are inappropriate. In any event, pursuant to MPEP § 2144.03, applicants respectfully request the Patent Office to provide documentary evidence of all alleged facts being Officially Noticed.

Although only claim 1 is discussed above, the same facts and arguments apply to overcome the rejection of claims 2-14. Since Zandi does not support the rejection of claim 1, it cannot be used to support a rejection of dependent claims 2-14. Further, as with claim 1, most of the limitations of claims 2-14 alleged to be present in Zandi are in fact absent from Zandi. A claim-by-claim refutation of those rejections is unnecessary, but representative claims are discussed below.

The zero-down-payment limitation of claim 2 is not mentioned at column 8, lines 1-12 of Zandi. The generating-pdf-files limitation of claim 4 is not disclosed at column 7, lines 3-7 or at column 6, lines 57-58.

The rejection of claim 5 contains the same type of improper taking of Official Notice as discussed above, being based on an assertion regarding loan applications. Pursuant to MPEP §

2144.03, applicants respectfully request the Patent Office to provide documentary evidence of all alleged facts being Officially Noticed.

Column 6, lines 39-58 does not disclose the claim 6 limitation of receiving information concerning the aggressiveness of the user's investments. This is not surprising, since the Office Action admits that Zandi does not disclose receiving information regarding the user's investments: That is, if Zandi does not disclose receiving investment information at all, it cannot disclose receiving investment information regarding aggressiveness of investments.

The rejections of claims 7-9 are likewise improper. Regarding the rejection of claim 8, pursuant to MPEP § 2144.03, applicants respectfully request the Patent Office to provide documentary evidence of all alleged facts being Officially Noticed.

Claims 15-41 are rejected under 35 U.S.C. § 103 over Zandi in view of U.S. Patent No. 5,8785,437. This rejection is respectfully traversed.

The Atkins patent appears to be cited solely as a reference disclosing the use of authenticating users in an electronic financial system. Zandi is the reference asserted to disclose all other claim limitations. The discussion above shows that Zandi does not disclose the limitations of claim 1, and claims 15-41 share many of those same limitations. Thus, a separate discussion of the impropriety of the rejection of claims 15-41 is not deemed necessary. That rejection should be withdrawn for the same reasons the rejection of claim 1 (and claims 2-14) should be withdrawn. Claims 15-41 are all directed to methods and systems for advising a potential borrower *before* a loan is applied for. Thus, neither Zandi nor any other loan-application-directed reference is going to anticipate (or render obvious) applicants' claims.

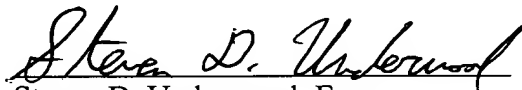
Finally, applicants note that the Office Action states (at the bottom of page 14): "Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection." Applicants realize that such language is mere Patent Office "boilerplate," but nevertheless respectfully submit that the language is clearly improper in this case. Applicants pointed out in the previous response that all claims were directed to *pre*-loan-application activities, yet the claims were again rejected based on the assumption that they're directed to loan-application activities. Therefore, it is clear that applicants' previous arguments were *not* considered and that they are *not* moot.

All claim rejections are believed to have been overcome by this Response. All pending claims are therefore believed to be allowable, and a prompt Notice of Allowance would be appreciated.

No fee is believed to be due with this Response. However, if any fee is due, please charge that fee to Deposit Account No. 50-0310.

Respectfully submitted,

Dated: August 4, 2004

A handwritten signature in cursive script, reading "Steven D. Underwood", written over a horizontal line.

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